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In re Application of
BROWN *et al*
U.S. Application No.: 10/581,545
PCT No.: PCT/GB2004/005090
Int. Filing Date: 03 December 2004
Priority Date: 03 December 2003
Docket No.: 13425-192US1/BV-1087 US
For: SYNTHESIS OF 2-SUBSTITUTED
ADENOSINES

DECISION

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 14 November 2008.

BACKGROUND

On 15 April 2008, the Office mailed a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath or declaration and surcharge fee were required. Applicants were given two months to respond with extensions of time available.

On 14 November 2008, applicants filed the subject petition which was accompanied by, *inter alia*, a declaration signed by three of the four joint inventors on behalf of the nonsigning inventor; a \$130.00 surcharge fee; a \$200.00 petition fee; a five-month extension of time and fee; a declaration of Neil Thornton; a declaration of Lars Höglund; and documentary evidence in support of the petition (exhibits A - B).

DISCUSSION

Applicants claim that co-inventor Dr. Jacqueline Valerie Anne Ouzman refuses to cooperate and have filed the subject petition under 37 CFR 1.47(a).

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the nonsigning joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventor.

The \$200.00 petition fee has been paid. The last known address of the

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nonsigning inventor was provided. An executed declaration meeting the requirements of section 409.03(a) of the MPEP and 37 CFR 1.497(a) and (b) was provided.

Regarding item (2), petitioners state that Dr. Ouzman has been unwilling to sign documents for the above-identified application without any payment from Biovitrium AB. See Thornton Decl. at ¶ 2 -3. Petitioners provided a copy of a letter dated 09 October 2007 indicating that a complete copy of the subject application (denoted as BV-1087US) was sent to the nonsigning inventor (exhibit A). Mr. Thornton confirms that Dr. Ouzman received these documents.¹ See Thornton Decl. at ¶ 2. Mr. Thornton states that "Dr. Ouzman has to date been unwilling to sign the declaration without payment of a fee." See Thornton Decl. at ¶ 3. This conduct is sufficient to constitute a refusal to join as contemplated by section 409.03(d)(II) of the MPEP.

Accordingly, all the requirements of 37 CFR 1.47(a) are complete.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is GRANTED.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 03 December 2004 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 14 November 2008.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record and will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.



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¹ The email dated 19 October 2007 indicates that Ms. Ouzman received a copy of patent number BV-1039US by email, not BV-1087US. Nonetheless, the statement by Mr. Thornton that Dr. Ouzman received the documents dated 09 October 2007 is sufficient to ensure receipt of the subject application.



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Dr. Ouzman:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. The counsel for the applicant is listed below. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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